

BEFORE:

MR SIMON THORLEY QC

IN THE MATTER OF THE TRADE MARKS ACT 1994

AND

**IN THE MATTER OF APPLICATION NO 2183690
BY MURGITROYD & CO LTD
TO REGISTER A MARK IN CLASSES 16, 41 & 42**

**APPEAL OF APPLICANT FROM DECISION OF MR A J PIKE
ACTING FOR THE REGISTRAR, DATED 15TH OCTOBER 1999**

MR RON JENKINS (Murgitroyd & Co Ltd) appeared for the Applicant

MR M KNIGHT appeared on behalf of the Trade Mark Registry

**D E C I S I O N
(as approved)**

Mr Thorley: This is an appeal from a decision of Mr Pike dated 15 October 1999 in which he refused to register an application by Murgitroyd & Company Management Services Limited, now assigned to Murgitroyd & Company Limited, for a trade mark in respect of the words “EVERY IDEA SAFELY DELIVERED” in classes 16, 41 and 42 of the register.

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The application was made on the 4 December 1998 and there was at that time no evidence of use. The question of registration therefore has to be considered in relation to an unused mark.

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The primary classes in respect of which registration is sought are classes 41 and 42. Class 42 registration is sought for intellectual property services, patent, trade mark, design and copyright advice and services and in class 41 for seminar and training services, seminar and training services relating to intellectual property. Mr Jenkins who appeared on this appeal on behalf of Murgitroyd & Company accepted that the class 41 and 42 marks were the main area of proposed use and that the class 16 mark in relation to printed matter was an adjunct thereto. Murgitroyd & Company are, are is well-known, a well established firm of patent and trade mark agents in Glasgow.

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Objection was taken to the application under sections 3(1)(b) and (c) of the Act because it was said that the mark consists exclusively of the words “EVERY IDEA SAFELY DELIVERED”, the whole purpose being a sign which may serve in trade to designate the kind, quality and intended purposes of the goods and services.

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On the appeal before me Mr Jenkins drew no distinction between Section 3(1)(b) and Section 3(1)(c) and, therefore, I can consider the matter in the round.

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The reasoning of the Hearing Officer for rejecting the mark is set out succinctly on page 2 of his decision as follows:

“The mark consists of ordinary dictionary words which are so well known that it is not necessary to set out any references for each of the individual words that constitute the mark. I am, in any case, bound to accept or reject the mark in its totality. I must,

therefore, consider the meaning of the mark as a whole. However, I consider it pertinent to emphasise one of the dictionary definitions of the word DELIVER.

5 “Collins English Dictionary (Third Edition Updated 1994) defines the word DELIVER as”
‘deliver the goods. Informal. To produce or perform something promised or expected’.

10 “In my view the phrase EVERY IDEA SAFELY DELIVERED is not invented but is one which indicates that the goods and services provided by the applicant are provided with the intention of ‘delivering’ a customers’ idea. A customer may secure the services of the applicant in order to protect that idea so that any benefits accruing from it will not be lost to a third party. Such ideas are often referred to as intellectual property and the goods and services contained within the specification applied for relate to the provision of training and advice aimed at protection of such ideas. The words EVERY IDEA SAFELY DELIVERED are ordinary dictionary words which are devoid of any distinctive character and, constitute a
15 sign that may be used in trade to designate the intended purpose of the goods and services.”

Mr Pike then went on to support the conclusion that he had reached by reference to a brochure (the MARISTA publication) which was put before him at the hearing, which showed the way in which Murgitroyd & Company had used the mark subsequent to the date of
20 application. Since it was subsequent to the date of application, it cannot be relevant as showing use and, in my judgment, it cannot be relied upon for any purpose other than supporting the initial view that Mr Pike reached. If Mr Pike’s initial view was correct, then there is not need to rely upon the MARISTA publication. If his original view is wrong, then nothing in the MARISTA publication can change it.

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It is common ground that when one is considering an unused mark the first impression is an important one. In the statement of grounds of appeal, in paragraph 5, it is stated that it is necessary to consider the mark as a whole, without artificially breaking it down into its component parts, because it is as a whole that the mark makes its first impression on the
30 consumer. I agree that this must be the correct approach with a mark which plainly is what could be categorised as a slogan mark. Mr Jenkins correctly emphasised that the word

“delivered” in natural parlance relates to the delivery of something tangible. He referred to a pizza on the one hand and a baby on the other. The latter reference becomes plainer when one looks at the MARISTA brochure, since that is plainly drawing a comparison between the work of a patent agent in bringing to grant an application for an intellectual property right with the
5 eventual delivery successfully of a baby. None the less, his argument before me and before Mr Pike was that ideas are not naturally tangible articles. They cannot be delivered in the sense of handing over and, indeed, the work of a patent and trade mark agent does not involve the delivery of ideas at all. It involves bringing to grant protection for intellectual property, which may in some cases be protection for an idea, but need not be.

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That said, undoubtedly one cannot consider the matters raised in section 3 (1)(b) and 3(1)(c) without having regard to the field of business in relation to which registration is sought. Plainly, in the present case it is in relation to the business of intellectual property services, and in that area the protection of ideas is obviously a paramount consideration. Taken in that field,
15 my first impression was that the word “delivered” was being used in a clever way but as undoubtedly creating the impression of protecting an idea.

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It is to my mind more than an oblique reference to part of the applicant’s business. It is, in my judgement, a very clear reference to part of the applicant’s business.

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Whilst I accept that it is oblique rather than being specific, and that therefore it may be capable of becoming distinctive as a result of use, my first impression was the same as that of Mr Pike, that there was too great an element of descriptiveness in the words “EVERY IDEA SAFELY DELIVERED” for it to have sufficient distinctive character without evidence of use.

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I have listened carefully to what Mr Jenkins has had to say and he has failed to satisfy me that my first impression was wrong. Therefore, in the circumstances this appeal will be dismissed.

Mr Thorley: Mr Knight, usual practice: no order as to costs sought?

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Mr Knight: Yes

Mr Jenkins: That is fine.

Mr Thorley: There will be no order as to costs.

5 Mr Knight: Thank you, sir.